

### Remarks/Arguments

#### 35 U.S.C. § 103

Claims 1, 6-10 and 13-18 were rejected as being unpatentable over Call (U.S. Patent No. 4,083,780).

Regarding the element of a down stream inlet, the examiner's position is "a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification." The applicant respectfully disagrees for the following reasons:

1. the cited art does not provide an enabling disclosure of the downstream inlet;
2. the proposed modification would render the prior art unsatisfactory for its intended purpose; and
3. the claimed element is not "shown" in the prior art, and in addition there is no suggestion or motivation of such in the references.

"References relied upon to support a rejection for obviousness must provide an enabling disclosure. That is to say, they must place the claimed invention in the possession of the public." *Beckman Instruments, Inc. v. LKB Produkter AB* 892, F.2d 1547 (Fed. Cir. 1989). An enabling disclosure is one which contains "sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention." *MPEP* 2164.01. The examiner relies on the following single sentence as an enabling disclosure for a downstream inlet: "Although it is preferable that all feed fluid be directed through the spiral wrap elements, this feature is not absolutely mandatory and brine seals may be omitted in some applications." The examiner's line of reasoning appears to be that omission of a brine seal would cause a bypass and somehow this inferred bypass is an enabled down stream inlet. It's not. Even if one were to read the inferred bypass as equivalent to a

downstream inlet, there is no accompanying description of the bypass and no figure showing the bypass. In short, there is nothing that teaches how to make and use a downstream inlet within the context of a multi-filter system.

Not only is the omission of a brine seal non-enabling of a downstream inlet, but it would render the prior art unsatisfactory for its intended purpose. Omission of brine seals would cause pressure to be uniform within the structure that houses the membranes. A system having a uniform pressure would simply not work because the pressure would be insufficient to force the feed fluid through the filters.

Perhaps most significantly, there is no suggestion or motivation to modify the teachings of Call to include a downstream inlet. I am sure the examiner is well aware that an applicant's disclosure cannot be used to provide such suggestion or motivation. *In re Vaeck* 947 F.2d 488 (Fed. Cir. 1991). Without the applicant's disclosure, the examiner would have to combine references to find a downstream inlet. Even if Call were combined with Eckman, this combination still fails to suggest or motivate a downstream inlet as contemplated by the claims. While it is true that Eckman teaches an orifice or a flow control which permits bypass, the teachings of Eckman do not minimize a pressure drop, but rather produce a pressure drop at least over the first several filters.

### **Conclusion**

Based on the failure of the references to teach or suggest each and every claim limitation of the independent claims, the applicant submits that all claims are now in condition for allowance.

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Serial No.: 10/019,066  
Attny Dkt. No. 100349.0055US1

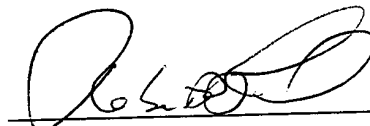
Art Unit: 1723  
Examiner: Krishnan S. Menon

Respectfully submitted,

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Dated: July 6, 2004

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